

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Serial No. | : | 10/064,104 |) | Confirm. No. 9166 |
| | | |) | |
| Appellant | : | Trese J. Vackar |) | |
| | | |) | |
| Filed | : | June 11, 2002 |) | |
| | | |) | |
| TC/Art Unit | : | 3732 |) | |
| | | |) | |
| Examiner | : | Rachel A. Running |) | |
| | | |) | |
| Docket No. | : | TVAC.01P |) | |
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| Cust. No. | : | 23732 |) | |
| | | |) | |

REPLY BRIEF

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PRESENT STATUS OF APPEAL

The EXAMINER'S ANSWER mailed February 26, 2007, was filed in response to the filing on June 17, 2006, of an AMENDED BRIEF ON APPEAL, which in turn was filed in response to an Office Action mailed June 7, 2006, which was in response to an Order from the Board mailed March 31, 2006, which requested the addition of a "Related Proceedings Appendix" (the original BRIEF ON APPEAL filed April 18, 2005, stated on page 1 that there were no related proceedings).

SUMMARY OF REPLY

Applicant has carefully reviewed the February 26, 2007, EXAMINER'S ANSWER, and particularly Section (10) "Response to

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Argument". It is disheartening to learn that despite a new Examiner, the Office demonstrates a continued insistence on converting the *threaded shaft* of Miller into a peg, notwithstanding the completely different fastening system underlying the Miller disclosure. This attempt to drive a threaded shaft through a smooth, round hole is the issue underlying the "Grounds of Rejection to be Reviewed on Appeal."

THE ARGUMENT

The "Grounds of Rejection" set forth in the Examiner's Answer mailed on June 7, 2005, and again in the Examiner's Answer mailed February 26, 2007, acknowledge that Benjamin (U.S. Patent No. 3,613,694) does not disclose a peg attached to the eyeglass frame, with the Examiner relying upon Miller (U.S. Patent No. 4,106,515) to provide the missing "peg" structure. The claims on appeal implicitly require such a structure, and absent such a disclosure in Miller, the §103(a) rejections must be withdrawn.

REBUTTAL TO EXAMINER'S "RESPONSE TO ARGUMENT"

The Examiner relies upon the definition of a peg cited by Appellant ("a small cylindrical pin used to fasten things") to qualify the threaded shaft 24 of Miller as a "peg." The lack of the word or concept of "outer threads" in the relied-upon definition considerably weakens the force of the Examiner's argument.

The Examiner conveniently omits another structure when applying the teachings of Miller in the "Grounds of Rejection" - a structure that is both critical to the operation of Miller and requires the "outer threads."

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Benjamin does not disclose a peg attached to the eyeglass frame and projecting therefrom. Miller discloses a peg (shaft 24) attached to a frame and projecting therefrom so that it can fit through an aperture (slit 32) of a trim guide (template 28), as discussed in column 2, lines 7-23. (EXAMINER'S ANSWER, Page 4)

Figure 2 is reproduced herein, and it is immediately apparent that the Examiner's analysis has conveniently overlooked the wing nut 38. Miller's fastening system requires both the threaded shaft 24 and the wing nut 38 to secure the vertical position of trimming template 28.

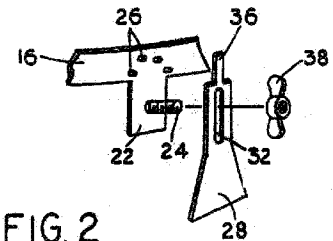


FIG. 2

The Examiner seeks to combine the above teachings of Miller with the teachings of Benjamin in the following manner:

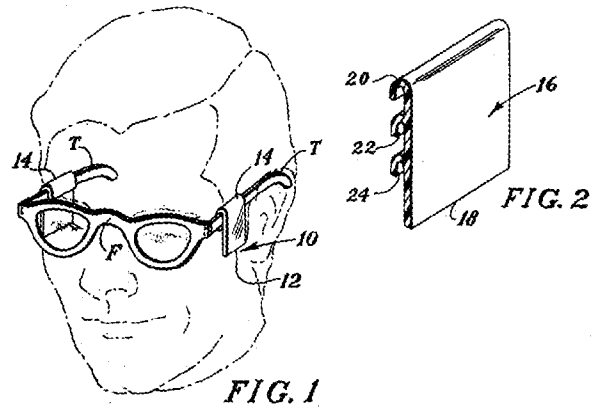
It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a peg attached to the temple of the frame of Benjamin, as taught by Miller, and an aperture on the trim guide of Benjamin, as taught by Miller, in order to provide a means for attaching the trim guide to the temple in such a way that the trim guide does not slide laterally out of position. (EXAMINER'S ANSWER, Page 4)

As noted in Appellant's APPEAL BRIEF, there are three requirements under §2143 M.P.E.P. to establish a prima facie case of obviousness: (1) motivation to modify or combine the reference(s); (2) a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all claim(s) limitations. The Examiner's combination fails under all three requirements.

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Benjamin teaches the use of a grooming device that attaches to a pair of eyeglasses using a hook means 14. As noted therein,

It is another object of this invention to provide a grooming device as described above that may be readily attached to and removed from a pair of eyeglasses.
(Column 1, Lines 33-35)



Under Benjamin's teaching, once the grooming device is unhooked, the temple piece T returns to its normal structure. Were one to modify the temple pieces as suggested by the Examiner, one or more "pegs" would remain projecting outwardly from the temple pieces while in use as eyeglasses. There can be no motivation in Benjamin to require the use of customized eyeglasses in order to obtain that noxious result.

The aperture in Miller is slit 32, which is provided to permit easy vertical adjustability of the template 28. The Examiner proposes making such a slit in the Benjamin trim guide, its purpose stated as being a way to laterally fix the position thereof. To prevent lateral sliding would require a vertical slit, which in turn would permit vertical sliding - probably a worse result where the goal is to have consistent sideburn length. In the face of such ambiguity, one cannot have a reasonable expectation of success.

As has been noted previously, both in the APPEAL BRIEF and herein, there is no teaching in either Benjamin or Miller to utilize a peg fastening system. The relevant claim language, "a trim guide selectively *pegged* to said eyeglass frame," requires

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the utilization of pegs. The Examiner's assertion that the Miller threaded shaft 24 is also a "peg" ignores the other necessary component of Miller fastening system - the wing nut 38.

To contend that "fasten using a peg" also encompasses the Miller screw/nut combinations broadens the term "pegged" to meaninglessness - one that might as well include rivet fastening systems. Claim interpretation is grounded in the specification and, where helpful, dictionary meanings (see discussion of Phillips v. AWH Corp. in the APPEAL BRIEF). The Examiner has failed to point to either in support of "pegged" meaning to fasten with a threaded shaft and wing nut. One must conclude that the prior art references fail to teach or suggest this critical claim limitation.

The "requirements" under §2143 M.P.E.P. are intended to prevent the recognized temptation to make use of hindsight in the Section 103 patentability analysis. The extraordinary lengths to which the Examiner is willing to argue in order to place threads on a peg evidence the siren call of hindsight in the Examiner's analysis. As set forth herein and in Appellant's BRIEF ON APPEAL, a prima facie case of obviousness has not been made. A withdrawal of the Section 103 rejections is respectfully requested.

CONCLUSION

Appellant has carefully reviewed the EXAMINER'S ANSWER, and has attempted to fairly and completely respond to the issues raised therein. For the reasons advanced in the foregoing argument, Appellant respectfully contends that each claim on appeal is patentable.

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Since Appellant has shown in the foregoing argument and in its BRIEF ON APPEAL that the cited references do not support the rejections, reversal of all rejections is courteously solicited.

Respectfully submitted,

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